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Paper No. 27

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**Mailed**

**APR 22 1998**

**Director's Office  
Group 2700**

In re Application of Alleman	:	
Application Serial No. 08/798,115	:	DECISION ON PETITION
Filed: February 12, 1997	:	37 CFR 1.181
Title: INTERACTIVE TELEPHONE SYSTEM	:	
FOR OPTIMIZING SERVICE ECONOMY	:	

This is a decision on the petition filed January 12, 1998 under 37 CFR § 1.181 (a) (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

Petitioner states that the owner of the application has been seeking patent protection for the invention for over five years. Petitioner refers to an application that was filed on April 24, 1992 and to a continuation in part application that was filed on June 2, 1994, and further refers to rejections of claims given by the examiner in those applications.

Under 37 CFR § 1.181(a), a petition may be taken to the Commissioner: (1) from any action or requirement of any examiner in the *ex parte* prosecution which is not subject to appeal to the Board of Patent Appeals and Interferences or to the Court. Furthermore, under 37 CFR § 1.181(f), except as otherwise provided for in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely.

37 CFR § 1.4(b) states that since each application file should be complete in itself, a separate copy of every paper to be filed in an application should be furnished for each application to which the paper pertains, even though the contents of the papers filed in two or more applications may be identical.

Inasmuch as petitioner's assertions through the middle of page 4 of the petition are directed to actions taken by the examiner in the parent applications, they are hereby dismissed as untimely inasmuch as such assertions were not filed within 2 months from the actions complained of in

accordance with 37 CFR § 1.181(f). Additionally, such assertions are not directed to matters within the instant application. Furthermore, such assertions are clearly directed to appealable issues which are in fact under appeal before the Board of Appeals and Interferences in the parent application. For these reasons, such assertions are dismissed inasmuch as they were not filed in the applications to which they pertain in accordance with 37 CFR § 1.4(b) and they are directed to appealable issues which are not petitionable under 37 CFR § 1.181(a)(1).

On page 4 of the instant petition, petitioner sets forth the first reference to the instant application, filed February 12, 1997. Petitioner states that because of a commitment in Florida on February 13, 1997 and a commitment in San Francisco on February 12, 1997, the only possible day for an interview during the trip was February 14, 1997. Petitioner also states that even though the examiner informed petitioner that Friday 14, 1997 was his day off, that it was his anniversary, and that he would not be available for an interview that day, the examiner reluctantly agreed to come in for an interview that day. Petitioner then states that when he arrived for the interview, the examiner was not in and that the supervisor chose to believe the examiner who denied that the interview had been arranged.

M.P.E.P. Section 713.02 states that "prior to filing, no interview is permitted". Notwithstanding statements from both the examiner and the supervisor that petitioner contacted the examiner approximately 2 weeks prior to filing the instant application to arrange the interview, it would seem from the filing date of February 12, 1997 of the instant application that petitioner must have arranged or attempted to arrange the interview at least prior to the filing, since petitioner by his own admission had other commitments that day and the day following. Furthermore, the interview summary of February 14, 1997 references the instant application by attorney docket number and filing date because the paperwork for the application had not been processed and it had not been assigned an application number. Furthermore, it is unclear how February 14, 1997 was the "only possible day" for the attorney to conduct an interview. No reasons were given as to why the interview could not have been scheduled the following week. Nonetheless, because the supervisor did grant an interview when petitioner arrived, the complaint in the instant petition under 37 CFR § 1.181(a)(3) relative to the examiner missing the interview is hereby dismissed as moot.

On page 5 of the petition, petitioner states that The Economist article "International Telephone Calls, the Privateers", dated September 12, 1992 was used primarily to reject claims in the parent case, which is under appeal.

As discussed supra, petitioner's assertions concerning actions taken by the examiner in the parent application are hereby dismissed as untimely inasmuch as such complaints were not filed within 2 months from the actions complained of in accordance with 37 CFR § 1.181(f). Furthermore, complaints directed to rejections made in the parent application are not directed to petitionable matters, nor are they directed to matters within the instant application. Rather, as stated by petitioner, these complaints are clearly directed to appealable issues which are in fact under appeal before the Board of Appeals and Interferences in the parent application. For these reasons, such complaints are dismissed inasmuch as they were not filed in the application to which they pertained in accordance with 37 CFR § 1.181(f) and 37 CFR § 1.4(b) and they are directed to

appealable issues which are not petitionable under 37 CFR § 1.181(a)(1).


Furthermore, on pages 5 and 6 of the petition, petitioner states that the above mentioned Economist article was used in combination with other references to reject claims in the instant application as well as the parent application and that the rejection based upon the referenced passage in the article is capricious for three reasons. The last rejection of record, i.e. the Final rejection, mailed December 30, 1997 does not use or reference the above mentioned Economist article. For these reasons, the complaints in regard to the use of the Economist article in the instant application are hereby dismissed as moot.

On page 6 of the petition, petitioner sets forth an additional reason for seeking supervisory authority of the Commissioner. This concerns a petition to make special which was filed on March 13, 1997. Petitioner states that because the application number was not known, the serial number in the caption of the petition was left blank by petitioner and a notation was made that the application was a continuation of the application that was pending before the Board of Appeals and Interferences. The petition was inadvertently sent to the Board of Appeals and Interferences because it was assumed to belong to that application. Petitioner states that the examiner did not intervene and informed him that the Petition to make Special could not be acted upon until the instant application was processed as a physical file. Petitioner states that it is the examiner's responsibility to see that the application file is processed and the petition sent to a petitions examiner. On page 7 of the petition, petitioner states that on July 16, 1997 a Writ of Mandamus was filed in the Federal Circuit seeking action from the Office either by way of a decision from the Board in the 1994 application or from the petitions examiner in the instant application.

It should be noted that the instant application was processed and made available for examination in June of 1997. Until the paperwork for the application was processed by the Office of Initial Patent Examination, the application file was not available to the examiner. Nonetheless, in addition to not providing the application number on the petition to make special, petitioner failed to mention that the filing date of the instant application was not included on the petition and the petition was filed without the necessary supporting Exhibit. On July 18, 1997, petitioner supplemented the petition to make special with the necessary supporting Exhibit (see paper No. 8). A decision granting the petition to make special was mailed July 21, 1997, three days after the Office received the necessary supporting Exhibit for the petition. For these reasons, the complaints against the examiner, the supervisor, and the petitions examiner concerning the petition to make special are dismissed.

On page 9, last paragraph of the petition, it is indicated that the Writ of Mandamus filed July 16, 1997 has been withdrawn by the petitioner.

On pages 8-11 of the instant petition, petitioner states that the examiner insists on rejecting claims under 35 USC Section 103 based on art having a date after the effective filing date of the application, that the examiner has added a rejection based on lack of enablement under 35 USC Section 112, that the article "You can't beat the price" has never been cited before and is not even listed on Form PTO-892, and that another new reference cited in the Final Rejection is the

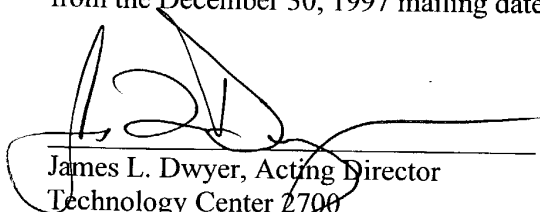


patent to Riskin. Petitioner further states that there is a need to supervise an examiner who refuses to allow an applicant to respond to new art.

M.P.E.P. § 706.07(a) clearly states that the examiner may introduce a new grounds of rejection and make the action final, when the new grounds of rejection is necessitated by an amendment. The final rejection, mailed December 30, 1997 was responsive to Amendment E (paper No. 21), filed November 14, 1997 which canceled all previous claims of record and added all new claims. The use of the prior art references which the examiner entitles "Examiner's Exhibit C" at page 10, paragraph 4 in the final rejection of December 30, 1997 (paper No. 24) is proper in so far as it is secondary reference relating to evidence in determining the state of the art and the establishment of the level of ordinary skill in the art at the time of applicant's invention, see *Gould v. Quigg* (CAFC), 3 USPQ2d 1302, *In re Hogan* 559 F. 2d 595, 605, 194 USPQ 527, 537 (CCPA 1977) and *Ex parte Erlich* (BdPatApp&Int), 22 USPQ2d 1463. Whether or not the evidence in "Examiner's Exhibit C" meets the criteria necessary for such determination, is a question of interpretation, subject to appeal. Therefore, the finality of the Office action, as well as the use of new art are deemed appropriate. The examiner's action in this regard is not arbitrary and is not subject to reversal under 37 CFR § 1.181. Petitioner's assertions outlined above in regard to the rejection of claims in the final rejection under 35 USC Section 103 and 35 USC Section 112 are appealable issues and therefore are not petitionable (see 37 CFR 1.181 § (a)(1)). Petitioner should also note that the aforementioned article "You can't beat the Price" was cited in the first Office action (see PTO-892, attachment to paper No. 14). For these reasons, the complaints in regard to the rejection of claims under 35 USC Section 103, 35 USC Section 112, and the complaint about the use of new prior art are hereby dismissed as they are matters for appeal to the Board of Appeals and Interferences.

For the above stated reasons, the petition is **DISMISSED**.

The three month shortened statutory period for response set in the final Office, continues to run from the December 30, 1997 mailing date thereof.



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